REMARKS

In the Office Action dated November 23, 1994, the Examiner rejected all pending claims under 35 U.S.C. § 112 and under 35 U.S.C. § 103 based on U.S. Patent No. 5,008,853 to Bly in view of U.S. Patent No. 5,173,854 to Kaufman. The Examiner also characterized Applicant's affidavit of commercial success as being insufficient to overcome a rejection under 35 U.S.C. § 103 on the grounds that Applicant failed to demonstrate a nexus between the claimed subject matter and the commercial success of third party products embodying the claimed subject matter.

The Applicant respectfully traverses the Examiner's rejection under 35 U.S.C. § 112 and otherwise contends that the pending claims are allowable over the prior art for the reasons stated below.

The pending claims are directed toward a computer file editing system including a plurality of personal computers (or terminals), each having a computer file review means or display, at least one personal computer having a multi-tasking processing means for automatically coordinating:

1. The execution of file editing operations on a given computer file comprising edits of less than the entire computer file inputted by at least one of the users; and

2. The transfer of data corresponding with and limited to such edits via interconnecting means to the others in the system in a predetermined manner;

wherein <u>the plurality of users are permitted to concurrently view the computer file</u> and wherein <u>the file editing operations and corresponding limited data transfer occur on a substantially real-time basis relative to said edit inputs to permit the plurality of remote users to review said edits substantially contemporaneously with the corresponding input thereof and execution of said file editing operations</u>.

I.   <u>Rejection Under 35 U.S.C. § 103</u>

Applicant respectfully submits that the Examiner has failed to meet the necessary burden to establish a prima facie case of obviousness under 35 U.S.C. § 103. None of the cited references or other prior art discloses or suggests a remote multiple-user file editing system as disclosed and claimed in the present invention, nor provides or even recognizes the advantages associated with a system providing the claimed capabilities.

Neither Bly nor Kaufman, alone or in combination, disclose or suggest a system having a plurality of personal computers with corresponding computer file review means, a personal computer having multi-tasking processing means <u>for coordinating</u> the execution of file editing operations on a given computer file <u>and</u> the transfer of data corresponding with and limited to the edits to others within the system in a predetermined manner, <u>wherein a</u>

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plurality of users are permitted to concurrently view the given computer file and wherein file editing operations and transfer of data occur on a substantially real-time basis relative to edit inputs to permit the system users to review edits to the given computer file substantially contemporaneously with the corresponding input thereof and execution of the file editing operations.

The Examiner's Office Action dated November 11, 1993, fails to address these specified failures of the prior art. The Examiner's understanding and recognition of this failure is critical since it goes to the very essence of the present invention; i.e., a computer file editing system that allows a plurality of users at remote locations to review file edits substantially contemporaneously with the input thereof, and that can be practiced in a variety of practical configurations. This distinction from the prior art must be appreciated to fully understand the combinative benefits of the claimed system components, including the addition of voice communication capabilities between system users so as to allow review/discussion of edits substantially contemporaneously with the corresponding inputs.

Bly discloses a document management software system including a structured data object for collaborative use by a plurality of users in a networked workstation environment. However, Bly neither discloses nor suggests a system which permits multiple remote users to concurrently view the same computer file and to review edits thereto substantially contemporaneously with the edit inputs.

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Rather, and in direct contrast to the claimed invention, the system disclosed in Bly allows only a single user to access a given file at any particular point in time.

In particular, the basic transaction pattern in the system disclosed in Bly is illustrated in FIG. 13 and discussed in Columns 23-24. Bly discloses an arrangement wherein:

1. First, a first user at a local workstation 14 selects a "shared book" (e.g. a file) stored at a remote host computer 24 upon which the user desires to perform edits;

2. Then, a separate database service is queried to determine whether the selected file is already locked by a second user;

3. Then, if the selected file is not already locked by another user, the database service grants the first user access to the selected file and places a lock on the selected file to prevent other users from accessing the selected file;

4. Then, the selected file is copied from the remote host computer 24 to the local workstation 14;

5. Then, the first user performs edits on the selected file from the first user's local workstation 14;

6. Then, when the first user is finished editing the selected file, the first user inputs commands indicating that the selected file should be saved;

7. <u>Then</u>, after the first user inputs such save commands, the file is copied back to the remote host computer 24;

8. <u>Then</u>, the remote host computer 24 directs the database service to remove the lock on the file to allow access by other users to the file;

9. <u>Then</u>, <u>only after the selected file is unlocked</u>, other users may access the selected file to review edits thereto.

It is apparent that, in direct contrast to the present invention, Bly discloses a file editing system which allows only a single user to view a file at any given point in time. When a first user on the system disclosed in Bly accesses a particular file, <u>all other users on the system are locked out of the file</u> and are, by design, precluded from viewing the file. In this regard, Bly actually teaches away from the present invention, wherein a plurality of users may concurrently view a given computer file.

Further, the system disclosed in Bly requires <u>sequential</u> editing of computer files, wherein a first user must save the <u>entire</u> file and exit before a second user may view or perform edits on the file. Bly does not contemplate or allow a plurality of remote users to concurrently view a computer file or to review edits substantially contemporaneously with the inputs thereof.

Additionally, Bly's primary purpose for creating a collaborative, multi-user document management system is to facilitate the efficient management of long-lived documents, such as books, in the publishing industry. Bly reflects no concern with

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establishing a system to permit a plurality of users to concurrently view a given computer file or to allow the users to review edits thereto by a given user substantially contemporaneously with the input thereof.

Finally, as to the Examiner's reference to Bly col. 4, lines 37-45 regarding a system different from that of Bly, it is respectfully submitted that such language does not support the Examiner's conclusion regarding the teaching thereof. Such language only indicates that when a given user undertakes a "pointing activity" such user's cursor is updated on other users' bitmaps. That is, such language does not support the notion that edits can be made and viewed by all users substantially contemporaneous with the input thereof.

Kaufman discloses a method for accomplishing distributed text processing wherein a computer file resident in the memory of a host computer may be edited from a remote terminal. Kaufman makes no suggestion of a system which allows a plurality of remote users to concurrently view portions of the same computer file and to edit portions of the same computer file and review such edits substantially contemporaneously with the edit inputs.

Further, Applicant submits that Kaufman does not teach the transmission of edit input data on a substantial real-time basis, as claimed in the present invention. Rather, as illustrated in Figs. 3-5, and described in Columns 5 and 6, the system disclosed in Kaufman accomplishes edits of a computer file by the following steps:

1. <u>First</u>, the host computer transmits a screen page of a selected file to a user located at a remote terminal;

2. <u>Then</u>, the screen page is displayed on the screen of the remote terminal;

3. <u>Then</u>, the user inputs desired edits to text on the transmitted screen page;

4. <u>Then</u>, the user selects an editing operation (e.g. insert, delete, replace) by performing a series of keystrokes and/or by pressing one or more function keys;

5. <u>Then</u>, <u>and only after</u> the user selects the editing operation by performing the preceding step, the terminal assembles an 'audit message' including the editing operation, the screen page coordinates, and the edit inputs, for transmission to the host computer;

6. <u>Then</u>, the audit message is transmitted to the host computer to effect the updating of the computer file.

It should be appreciated that the sequential, user driven, updating process required by the system disclosed in Kaufman is incapable of accomplishing file editing operations and data transfer for viewing on a substantially real time basis relative to said edit inputs as claimed in the present invention. Instead, Kaufman requires the user to initiate the data transfer by pressing a series of keystrokes. A user prompted system, as disclosed in Kaufman, simply cannot operate on a real-time basis as claimed in the present invention.

In view of the foregoing, Applicant submits that neither Bly nor Kaufman disclose or render obvious the subject matter of the presently claimed invention. Further, Applicant contends that the examiner has improperly combined Bly with Kaufman because there is no suggestion or motivation to combine Bly with Kaufman to yield the present invention. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined <u>only</u> if there is some suggestion or incentive to do so." <u>In re Fritch</u> 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Bly addresses the problem of managing long-lived documents in a multiple user environment such as the publishing industry by providing a shared data structure including a number of related files that may be accessed at different times by designated, sequential, single users of the system. Bly lacks any suggestion or incentive to incorporate concurrent viewing of files by a plurality of users or substantial real-time data transmission of edits to a file with the system disclosed in Bly. To the contrary, Bly explicitly teaches away from providing these capabilities in order to maintain the integrity of the data in the most current version of a file. <u>See</u>, <u>e.g.</u> Column 10, lines 21-25 (means is provided for locking up one or more data entries by an individual user and thereby preventing access of the locked entries by other users to prevent concurrent editing and other changes to the same entries by two or more users). Kaufman, being directed toward a

user-driven distributed processing text editing system, can not suggest the extensive modifications necessary to Bly (e.g. concurrent viewing of a file by a plurality of users coupled with substantial real-time review of edits made to the file) to yield the claimed invention. Nor is Applicant aware of knowledge generally available to a person of ordinary skill in the relevant art which would have led the person to combine Bly with Kaufman. Accordingly, Applicant respectfully submits that the Examiner has not met the burden to produce evidence to support the combination and that the Examiner's rejection is based on improper hindsight.

Further, Applicant submits that, even if the Examiner were to present evidence supporting the combination of Bly with Kaufman, or other prior art, such combination would not yield the present invention or render the present invention obvious. The prior art simply does not contemplate an operating environment in which a plurality of users have the ability to concurrently view portions of a computer file and to review edits made to the file on a substantially real time basis. These claimed features of the present invention are not disclosed in any prior art reference, either alone or in combination.

II.   Rejection Under 35 U.S.C. § 112

With respect to the Examiner's rejection under 35 U.S.C. § 112, Applicant respectfully submits that the claims as pending do not imply that simultaneous edits can be made to the same portion of a file. Rather, the pending claims recite a system including a

personal computer having multi-tasking processing means to coordinate file editing operations and data transfer, wherein a plurality of users at remote locations can review edits to a given file <u>substantially contemporaneously</u> with the input thereof.

III. <u>Applicant's § 1.132 Affidavit of Commercial Success</u>

With regard to Applicant's previously filed Affidavit pursuant to 37 C.F.R. § 1.132, Applicant respectfully submits that the Affidavit provides sufficient evidence to support a showing of commercial success of the invention claimed in the patent.

More specifically, Applicant refers the Examiner to the previously recited passages from the articles discussing the ASPECTS software package submitted with Applicant's Affidavit:

> "[T]he program is designed to fill gaps left by electronic mail and video conferencing. In what amounts to a conference call over a computer, it allows participants to work together simultaneously on the same document. Each person can change or add material ... while seeing what the others are doing. ... The goal of this kind of software is to make it possible for widely dispersed people to participate jointly on a common problem." <u>The New York Times</u>, June 23, 1991.

<center>* * *</center>

> "Aspects allow users to send and receive messages, talk on the phone and type onto the same document. That's ideal for brainstorming sessions involving colleagues as

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distant as the next building or the next country." <u>USA</u>
<u>Today</u>, October 21, 1991.

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"<u>This is the first time I have heard of simultaneous</u>
<u>editing on any kind of computer</u>." (emphasis added)
<u>INFOWORLD</u>, August 6, 1990, p. 98.

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"But what seems to have really pushed groupware into
maturity is the release of ... Aspects 1.0 ... It's also
the first true group work product. Aspects came on the
scene when it looked as though groupware was going
nowhere fast." <u>MacUser</u>, June 1991, pp. 207-211.

Applicant submits that the articles submitted regarding the
"ASPECTS" product reasonably establish that the commercial success
of the product is attributable to the features of the invention
claimed in the present application. The subject software clearly
has the primary purpose of establishing an environment in which a
plurality of users can perform edits on portions of a computer file
and can review such edits on a substantially real-time basis, as
claimed in the present invention. Applicant submits that it would
be unfairly burdensome to require Applicant to provide proof to
negate any and all imaginable factors contributing to the success
of the subject software. See, e.g., <u>Demaco Corp. v. F. Von</u>
<u>Langdorf Licensing Ltd.</u>, 7 USPQ 2d 1222, 1227 (Fed. Cir. 1988).

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Applicant further intends to file a second Affidavit as per Appendix A attached hereto as further evidence of the patentability of the claimed invention. Applicant refers the Examiner to the following selected quotes from the Shareview 300 product literature to be submitted with the Affidavit per Appendix A:

"[Y]ou can simultaneously talk and collaborate on shared documents over one ordinary telephone line" (page 1)

"You can both work on the same document from popular Macintosh software applications. You have simultaneous control of the same shared window..." (page 2)

The Examiner is further referred to the following selected quotes from the Intel Pro-Share Personal Conferencing product literature to be submitted with the Affidavit per Appendix A:

"By adding the power of your PC to your one-on-one communications, you will be able to simultaneously share ideas" (Text Page 1)

"The family of Pro-Share products is designed to let you and a partner have discussions within any Windows document. That means that both of you can see changes and comments on your screen as they are made." (Text Page 1)
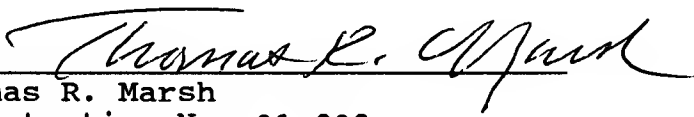
"And you both see the changes simultaneously." (Text Page 1)

Applicant submits that the above-referenced materials describe a commercially successful system which and three commercially available systems that coincide with the claimed invention. Each of the systems described establish an environment in which multiple remote users may concurrently view the same computer file and may input edits to portions of the file and wherein the edits may be reviewed by other users on a substantial real-time basis. This operating environment is encompassed by the present invention as claimed.

In view of the foregoing, Applicant submits that all pending claims are allowable over the art and such favorable disposition is earnestly solicited. The outstanding drawing objection will be attended to upon indication that the pending claims are allowable. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned attorney by collect telephone call.

Respectfully submitted,

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April 25, 1994

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